

## **REMARKS**

In view of the above amendments and the following remarks, reconsideration and further examination are respectfully requested.

### **I. Amendments to the Specification and Abstract**

The specification and abstract have been reviewed and revised to improve their English grammar. No new matter has been added.

### **II. Amendments to the Claims**

Independent claims 1, 10 and 11 have been amended to clarify features of the invention recited therein and to further distinguish the present invention from the references relied upon in the rejections discussed below.

It is also noted that claims 1, 3-7, 10 and 11 have been amended to make a number of editorial revisions thereto. These editorial revisions have been made to place the claims in better U.S. form. Further, these editorial revisions have not been made to narrow the scope of protection of the claims, or to address issues related to patentability, and therefore, these amendments should not be construed as limiting the scope of equivalents of the claimed features offered by the Doctrine of Equivalents.

In view of the election of claims 1, 3-7, 10 and 11, claims 2, 8 and 9 have been identified as being withdrawn.

### **III. 35 U.S.C. §101 Rejection**

Claim 11 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, claim 11 was rejected for reciting an invention that can be interpreted as software alone. Therefore, claim 11 has been amended to recite that the program is recorded on a computer-readable recording medium and causes a computer to execute a method. As a result, withdrawal of this rejection is respectfully requested.

### **IV. 35 U.S.C. § 102 Rejection**

Claims 1, 10 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jun. This rejection is believed clearly inapplicable to amended independent claims 1, 10 and 11 and the claims that depend therefrom for the following reasons.

Amended independent claim 1 recites an apparatus for reproducing a moving image file recorded on a recording medium. Specifically, claim 1 recites that the apparatus includes a calculating unit that calculates a thinning-out ratio of index information based on size information of a memory (of the apparatus) and size information of a table that holds the index information that is for the reproduction of the moving image file. In addition, claim 1 recites that the apparatus includes a writing unit that thins out the index information based on the thinning-out ratio and then writes the thinned-out index information into the memory. Jun fails to disclose or suggest the above-mentioned distinguishing features as recited in amended independent claim 1.

Rather, Jun merely teaches when an entry field 40 of Sync Sample box 214 is used up, information having already been stored in the entry field 40 is thinned out to allow the adding of

new information. More specifically, Jun teaches that index information is recorded sequentially in a memory, and the index information that has already been stored in the memory is thinned out when the data amount of the index information already stored in the memory exceeds a capacity of the memory, so that new index information can be recorded on a free space in the memory that has been secured by the thinning out (see paragraphs [0074] and [0075]).

Thus, in view of the above, it is clear that Jun teaches that the index information that has already been stored in the memory is thinned out when the data amount of the index information already stored in the memory exceeds a capacity of the memory, but fails to disclose or suggest the writing unit that thins out the index information based on the thinning-out ratio and then writes the thinned-out index information into the memory, as recited in claim 1.

In other words, Jun teaches thinning out information already stored in the memory to make room for new information, but fails to disclose or suggest thinning out the index information and then writing the thinned-out index information into the memory, as required by claim 1.

Furthermore, even though Jun teaches thinning out (previously stored) information, Jun still fails to disclose or suggest the calculating unit that calculates the thinning-out ratio based on size information of the memory and size information of the table that holds the index information, as recited in claim 1.

Therefore, because of the above-mentioned distinctions it is believed clear that independent claim 1 and claims 3-7 that depend therefrom are not anticipated by Jun.

Please note that one of the benefits of the structure required by claim 1 is that it is possible to record the index information in a memory, even when a size of a table holding the index information is larger than the entire size of the memory, by thinning out the index

information before it is recorded in the memory. In light of the discussion above, Jun does not provide the above-mentioned benefits of the structure required by claim 1, because Jun fails to disclose or suggest thinning out the index information and then writing the thinned-out index information into the memory, as required by claim 1.

Furthermore, there is no disclosure or suggestion in Jun or elsewhere in the prior art of record which would have caused a person of ordinary skill in the art to modify Jun to obtain the invention of independent claim 1. Accordingly, it is respectfully submitted that independent claim 1 and claims 3-7 that depend therefrom are clearly allowable over the prior art of record.

Amended independent claims 10 and 11 are directed to a method and a program, respectively and each recite features that correspond to the above-mentioned distinguishing features of independent claim 1. Thus, for the same reasons discussed above, it is respectfully submitted that claims 10 and 11 are allowable over the prior art of record.

#### **V. 35 U.S.C. § 103(a) Rejection**

Dependent claims 3-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jun in view of Ohsawa (secondary reference). In view of the above, it is respectfully submitted that this secondary reference does not disclose or suggest the above-discussed features of independent claim 1 which are lacking from the Jun reference. Therefore, no obvious combination of Jun with the secondary reference would result in, or otherwise render obvious, the invention recited independent claim 1 and claims 3-7 that depend therefrom.

## **VI. Conclusion**

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance and an early notification thereof is earnestly requested. The Examiner is invited to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,

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